The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte JOSEPH P. STEINER
and GREGORY S. HAMILTON

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Appeal No. 2003-1102
Application No. 09/784,174

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ON BRIEF

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Before WILLIAM F. SMITH, SCHEINER and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is related to Application Serial Number 09/781,427 (Appeal No. 2003-0924) and Application Serial Number 09/879,888 (Appeal No. 2003-1169).

As an initial matter, we note that 35 U.S.C. § 6(b) sets forth the following:

> (b) Duties.—**The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review** [emphasis added] adverse decisions of examiner's upon applications for patents and shall determine

> priority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

Accordingly, we serve as a Board of review and not as a *de novo* examination tribunal, and therefore must remand this application to the examiner to attend to the following matters.

I.

The sole rejection pending in this application is a provisional rejection under the judicially created doctrine of obviousness-type double patenting.

The examiner rejects instant claims 5, 6, and 8 over claims 17-32 of related Application No. 09/879,888 (Appeal No. 2003-1169).

The examiner states that instant claims 5, 6, and 8 read on the claims of Application Serial Number 09/879,888 "when J and K in claims 5, 6, and 8 form a heterocyclic ring and the heterocyclic ring in the claims of each application are substituted with the same second heterocyclic atom". Answer, page 4.

In response to the rejection, appellants argue that "overlap itself cannot support a double patenting rejection". Brief, page 3.

We note that the determination of obviousness-type double patenting essentially involves the determination of obviousness under 35 U.S.C. § 103, except that the first patent disclosure is not applicable as "prior art." See, e.g., Chisum, § 9.03[3]. In In re Longi, the Federal Circuit discussed the similarity between rejections under § 103 and "obviousness-type" double patenting:

> We note that the Board did not make the instant rejection under § 103. However, a double patenting of the obviousness type rejection is "analogous to [a failure to meet] the non-obviousness requirement of 35 U.S.C. § 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 600, n.4, 54 C.C.P.A. 1589, 1597, n.4, 154 USPQ 29, 34 (1967). Therefore, our analysis concerning the correctness of the Board's decision in the instant case parallels our previous guidelines for a § 103 rejection. See, e.g., In re De Blauwe, 736 F.2d 699, 222 USPQ 191 (Fed. Cir. 1984).

In re Longi, 759 F.2d at 892 n.4, 225 USPQ at 648 n.4.

Because the analysis regarding obviousness-type double patenting essentially involves the determination of obviousness under 35 U.S.C. § 103, we note that obviousness under Section 103 is a legal conclusion based upon facts revealing the scope and

content of the prior art, the differences between the prior art and the claims at issue, the level of ordinary skill in the art, and objective evidence of nonobviousness. Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Upon return of the application, the examiner is to therefore reweigh the entire merits of the obviousness-type double patenting rejection according to the criteria set forth in Graham v. John Deere Co.

Furthermore, in the case of In re Lee, 277 F.3d 1338, 1445, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002), the Court stressed the import of articulating and making of record knowledge negating patentability. The examiner is therefore also to reweigh the entire merits of the rejection and make of record any facts supporting her position negating patentability.

In response to appellants' statement that "overlap itself cannot support a double patenting rejection", the examiner is to reweigh the entire merits of the obviousness-type double patenting rejection in light of In re Kaplan, 789 F.2d 1574, 1577-1581, 229 USPQ 678, 681-683 (Fed. Cir. 1987). In this context, the examiner is to expound on the obviousness-type double patenting rejection according to the analysis set forth in In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir.

1994) and In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992).

II.

The instant claims recite the phrase "an effective amount". Upon return of the application, the examiner is to consider what amount is meant by this phrase, and for what purpose, and whether this phrase is indefinite under 35 U.S.C. § 112, second paragraph.

III.

Upon return of the application, the examiner is to compare the claims of related Application Serial Number 09/781,427 (Appeal No. 2003-0924), to assess whether the claims of this related application affect the patentability of the claims in the instant case.

This application, by virtue of its "special" status, requires an immediate action, MPEP § 708.01(d). It is important

that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

William F. Smith )
Administrative Patent Judge )
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Toni R. Scheiner ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS AND
) INTERFERENCES
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Beverly A. Pawlikowski )
Administrative Patent Judge )

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Application 09/784,174

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